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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,082	08/14/2000	Jeffrey A. Dean	Google-3 (GOOGP008)	1030
44989	7590	05/30/2006	EXAMINER	
HARRITY SNYDER, LLP 11350 Random Hills Road SUITE 600 FAIRFAX, VA 22030			BASHORE, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,082

Applicant(s)

DEAN ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7-14, 16-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5, 7-9, 12-14, 16-19 and 22 is/are allowed.
- 6) ☒ Claim(s) 10, 11, 20, 21, 23, 24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 9/14/2005, to the original application filed 8/14/2000, with provisional filing date 4/6/2000.
2. It is noted that Examiner Peter Smith is no longer the examiner of record of the instant case. The new examiner of record for this case is William L. Bashore. Please update future correspondence accordingly.
3. Claims 1-3, 5, 7-14, 16-24, 26 pending. Claims 4, 6, 15, 25 have been canceled. Claims 1, 10, 12, 20, 22, 23, 26 are independent claims.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/2005 has been entered.

Claim Rejections - 35 USC 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10-11, 20-21, 23-24, and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Dependent claims 11 and 21 include a "carrier wave" which is non-

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statutory because it does not fit into any of the three statutory product classes because it is non-physical. See

MPEP 2106:

For the purposes of a 35 U.S.C. 101 analysis, it is of little relevance whether the claim is directed to a machine or a process. The legal principles are the same. *AT & T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357, 50 USPQ2d 1447, 1451 (Fed. Cir. 1999).

(a) Statutory Product Claims

Products may be either machines, manufactures, or compositions of matter.

A machine is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

A manufacture is "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand labor or by machinery." *Chakrabarty*, 447 U.S. at 308, 206 USPQ at 196-97 (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)).

A composition of matter is "a composition of two or more substances [or] . . . a[] composite article, whether [it] be the result of chemical union, or of mechanical mixture, or whether . . . [it] be [a] gas[], fluid[], powder[], or solid[]" *Id.* at 308, 206 USPQ at 197 (quoting *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 SPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958)).

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory. In most cases, a claim to a specific machine or manufacture will have a practical application in the technological arts. See *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 ("the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an abstract idea but rather a specific machine to produce a useful, concrete, and tangible result."); and *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601 ("the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces a useful, concrete and tangible result - a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades."). Also see *AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.).

The three statutory product classes have traditionally required physical structure or matter. The claimed carrier wave has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine. The claimed carrier wave is not matter, but a form of energy, and therefore is not a composition of matter. A manufacture can be an article produced from raw or prepared materials by manipulating the raw or prepared materials. A manufacture is also defined as the residual class of product. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. Thus, the Examiner concludes that the claimed carrier wave is not one of the three statutory product classes.

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Independent claims 10, 20, and 23 are rejected as non-statutory because they recite a computer readable medium, which in view of Applicant's disclosure, specification page 6 line 19 - page 7 line 2, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., CD-ROM, floppy disk, tape, flash memory, system memory, and hard drive) and intangible embodiments (e.g., data signal embodied on a carrier wave). As such, these claims are not limited to statutory subject matter and is therefore non-statutory.

In regard to independent claim 26, the combined limitations within said method claim are substantially directed to manipulations of data (i.e. an algorithm for grouping, sorting, identifying, and examining), thus said claim does not appear to be directed to a useful, concrete, and tangible result.

Allowable Subject Matter

7. Claims 1-3, 5, 7-9, 12-14, 16-19, 22 are allowed.
8. Claims 10-11, 20-21, 23-24, 26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

Response to Arguments

9. Applicant's arguments with respect to the pending claims (regarding art based rejection) have been considered but are moot.

Applicant argues that a carrier wave is statutory. It is respectfully noted that a carrier wave is considered non-statutory under the new 35 U.S.C. 101 Interim Guidelines.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

May 25, 2006